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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,504	07/29/2002	Peter Brune	RBL0087	9383
7590		05/19/2004	EXAMINER	
Baker & Daniels		KARMIS, STEFANOS		
Suite 800		ART UNIT		
111 East Waney Street		PAPER NUMBER		
Fort Wayne, IN 46802		3624		

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/089,504

Applicant(s)

BRUNE ET AL.

Examiner

Stefano Karmis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address.

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

1. The following communication is in response to Applicant's response received on 09 March 2004.

#### ***Status of Claims***

2. Claims 1-5 and 7-19 are left as previously presented. Claim 6 has been previously cancelled. Therefore, claims 1-5 and 7-19 are under prosecution in this application.

#### ***Summary of this Office Action***

3. Applicant's response on 09 March 2004 has been fully considered and is discussed in the next section below or within the following rejection. Claims 1-5 and 7-19 have been rejected under the prior art cited below and Applicant's request for allowance is respectfully denied at this time.

#### ***Response to Arguments***

4. Applicant's arguments with respect to claim 1-5 and 7-19 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 7 is rejected under 35 U.S.C. 102(e) as being anticipated by Langseth et al. (hereinafter Langseth) U.S. Patent 6,694,316.

Regarding independent claim 7, Langseth teaches a method for charging Internet services via a mobile telephone, comprising coupling standard dealer software with standard (Internet) payment systems and Internet-enabled standard mobile telephone terminals (column 7, lines 27 thru column 8, line 52 and column 15, lines 55-65).

*Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claim 1-5 and 8-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hannula et al. (hereinafter Hannula) U.S. Patent 6,366,893 in view of Langseth et al. (hereinafter Langseth) U.S. Patent 6,694,316 in further view of Toader et al. (hereinafter Toader) U.S. Patent 5,749,075.

Regarding independent claim 1, Hannula teaches a method for using and charging services via a mobile telephone through use of the Internet accessed by the mobile phone

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comprising: establishing a payment gateway, which is accessible by a mobile telephone service user via a mobile telephone terminal and by a provider via a provider server, where customer data of the user can be held centrally in a database of the payment gateway (column 5, lines 56-65 and column 6, lines 11-16). Hannula fails to teach opening a micropayment account at a bank, where the payment gateway and the micropayment account are continuously synchronized by means of matching the databases and reserving a certain amount in the micropayment account via the payment gateway and authorized by the user to the provider, the provider debiting amounts against the amount reserved, transmitting the actual charge(s) from the provider to the payment gateway upon conclusion of the process, and allocating the actual charges to the reserved certain amount, wherein the payment gateway debits the amounts to the micropayment account, credits the provider and cancels the respective reserved certain amount. Toader teaches a method for prepaid Internet access with the use of specialized cards. These cards are purchased for up to a specified amount and the user may log off at any time and be charged for access actually used by the user (column 5, lines 6-27 and column 6, lines 8-39). Furthermore Langseth teaches a method for receiving Internet services to a mobile phone from a provider based on information stored in a subscriber database (column 7, line 27 thru column 8, line 52). It would be obvious to one of ordinary skill in the art that the teachings of Hannula to pay fees for services to a mobile phone could be modified to include the teachings of Langseth which specifies that the service delivered to the cell phone be that of an Internet service because the user in both systems is receiving a service to a cellular phone by purchasing the desired subscription. Furthermore it would also have been obvious to one of ordinary skill in the art that the teachings of Hannula and Langseth could be modified to include the payment reservation

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technique for Internet service as taught by Toader because it provides an efficient manner to purchase Internet services other than with a one time traditional fee. This provides sufficient motivation to combine the teachings of Hannula, Langseth and Toader, and provide for a payment gateway requiring actual charges from a predetermined maximum available amount of Internet service available to mobile telephone.

Claim 2, Hannula teaches that no electronic money purse data and no customer data are held in the terminal (column 6, lines 11-19).

Claims 3 and 8, Toader teaches securing all payment transactions by means of a customer payment PIN (column 5, lines 28-38).

Claims 4 and 9-10, Hannula teaches limiting sensitive data safely within the mobile telephone network and not transmitting sensitive data via the Internet (column 4, lines 4-23).

Claims 5 and 11-13, authenticating the customer via the mobile telephone network (column 7, lines 25-67).

Claims 14-18, Toader teaches the reserving step receives matching data relating to the reserved certain amount from the user terminal and the provider (column 5, lines 4-38). Toader fails to teach that the terminal for the Internet service is a mobile phone. It would be obvious to one of ordinary skill in the art that the teachings of Hannula to pay fees for services to a mobile

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phone could be modified to include the teachings of Langseth which specifies that the service delivered to the cell phone be that of an Internet service because the user in both systems is receiving a service to a cellular phone by purchasing the desired subscription. Furthermore it would also have been obvious to one of ordinary skill in the art that the teachings of Hannula and Langseth could be modified to include the payment reservation technique for Internet service as taught by Toader because it provides an efficient manner to purchase Internet services other than with a one time traditional fee. This provides sufficient motivation to combine the teachings of Hannula, Langseth and Toader, and provide for a payment gateway requiring actual charges from a predetermined maximum available amount of Internet service available to mobile telephone.

Regarding independent claim 19, Hannula teaches a method for using and charging services via a mobile telephone through use of the Internet accessed by the mobile phone comprising: establishing a payment gateway, which is accessible by a mobile telephone service user via a mobile telephone terminal and by a provider via a provider server, where customer data of the user can be held centrally in a database of the payment gateway (column 5, lines 56-65 and column 6, lines 11-16). Hannula fails to teach opening a micropayment account at a bank, where the payment gateway and the micropayment account are continuously synchronized by means of matching the databases and reserving a certain amount in the micropayment account via the payment gateway and authorized by the user to the provider, the provider debiting amounts against the amount reserved, transmitting the actual charge(s) from the provider to the payment gateway upon conclusion of the process, and allocating the actual charges to the



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reserved certain amount, wherein the payment gateway debits the amounts to the micropayment account, credits the provider and cancels the respective reserved certain amount. Toader teaches a method for prepaid Internet access with the use of specialized cards. These cards are purchased for up to a specified amount and the user may log off at any time and be charged for access actually used by the user (column 5, lines 6-27 and column 6, lines 8-39). Furthermore Langseth teaches a method for receiving Internet services to a mobile phone from a provider based on information stored in a subscriber database (column 7, line 27 thru column 8, line 52). It would be obvious to one of ordinary skill in the art that the teachings of Hannula to pay fees for services to a mobile phone could be modified to include the teachings of Langseth which specifies that the service delivered to the cell phone be that of an Internet service because the user in both systems is receiving a service to a cellular phone by purchasing the desired subscription. Furthermore it would also have been obvious to one of ordinary skill in the art that the teachings of Hannula and Langseth could be modified to include the payment reservation technique for Internet service as taught by Toader because it provides an efficient manner to purchase Internet services other than with a one time traditional fee. This provides sufficient motivation to combine the teachings of Hannula, Langseth and Toader, and provide for a payment gateway requiring actual charges from a predetermined maximum available amount of Internet service available to mobile telephone.

*Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a) Morrill, Jr., US Patent 5,991,749 Nov. 23, 1999. Wireless telephony for collecting tolls, conducting financial transactions, and authorizing other activities.
- b) Heinonen et al., US Patent 6,078,806 Jun. 20, 2000. Method for using applications in a mobile station, a mobile station, and a system for effecting payments.
- c) Vatanen, US Patent 6,169,890 Jan. 2, 2001. Mobile telephone system and method for carrying out financial transactions using a mobile telephone system.
- d) Chavez, Jr. et al., US Patent 6,256,299 Jul. 3, 2001. Automatic service provider notification of unauthorized terminal activity.
- e) Theimer, US Patent 6,519,241 Feb. 11, 2003. Mobile telephone for Internet applications.
- f) Schilling, US Patent 6,726,098 Apr. 27, 2004. Performing local transactions using a wireless radio unit.
- g) Nilson US Publication 2002/0156729 Oct. 24, 2002. Payments in a telecommunications system.
- h) Lehto US Publication 2003/0060186 Mar. 27, 2003. Method and system for the effecting payments by means of a mobile station.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully Submitted  
Stefano Karmis  
May 13, 2004



**HANI M. KAZIMI**  
**PRIMARY EXAMINER**